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10/690,821	10/23/2003	Kee-Hung Lai	P69237US0	5436
7590 JACOBSON HOLMAN 400 SEVENTH STREET, N.W. WASHINGTON, DC 20004		02/07/2007	EXAMINER BARBEE, MANUEL L	
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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/690,821  
Filing Date: October 23, 2003  
Appellant(s): LAI ET AL.

**MAILED**  
FEB 07 2007  
**GROUP 2800**

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John C. Holman  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 14 November 2006 appealing from the Office action mailed 8 March 2006.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows:

This appeal involves claims 1-9, 11 and 12. Claims 1-9, 11 and 12 stand rejected under 35 U.S.C. § 112, first paragraph, as stated by appellant. However, the rejection to claims 1-9, 11 and 12 under 35 U.S.C. § 112, second paragraph has been withdrawn.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows: The rejection under 35 U.S.C. § 112, second paragraph is withdrawn.

### **WITHDRAWN REJECTIONS**

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner. The rejection of claims 1-9, 11 and 12 under 35 U.S.C. § 112, second paragraph.

### **(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

### **(8) Evidence Relied Upon**

6,486,899	BUSH, JR.	11-2002
2002/0049622	LETTICH ET AL.	4-2002
2002/0010606	SOGA ET AL.	1-2002

### **(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-9, 11 and 12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Structure of the instrument for evaluating supply chain performance is not enabled by the disclosure. Claims 1-4, 6-9, 11 and 12 are directed to instruments with a plurality of measurement items divided into at least three dimensions. Claim 5 is a method claim directed to providing an instrument that evaluates performance based on measurement items. The specification, from page 7, line 18 - page 8, line 22, discusses

domain specification and instrument development, including a statement that service effectiveness for shippers (SES) and service effectiveness for consignees (SEC) may be operationalized by modifying the SERVQUAL instrument developed by Parasuraman, Zeithaml and Berry (1988) (page 6, lines 19-25). The disclosure provides no further information with regard to the SERVQUAL instrument or the reference to Parasuraman et al. The disclosure states that operational efficiency for transport logistics service providers (OE) is operationalized by five broad categories of logistics performance and is not related any instrument (page 8, lines 6, 7). The disclosure does not include any disclosure for how any instrument would relate measurement items for SES, SEC or OE to the supply chain performance.

One of ordinary skill would not have been enabled to carry out the invention. None of the cited prior art (US Patent No. 6,486,899, US Patent Application Publication 2002/0049622), US Patent Application Publication 2002/001606) teach using an instrument that includes all the measurement items in the claims to evaluate supply chain performance. While the '899 patent to Bush displays logistics information, it does not teach how measurement items may be collected with a questionnaire, which is disclosed as an instrument in the specification, or how any such measurements may be used to evaluate supply chain performance. The prior art along with the disclosure does not enable one of ordinary skill to make and use the instrument claimed.

The instrument is not predictable, and the inventor provides little guidance. The specification does not disclose any specific way to measure the measurement items. Only a questionnaire is disclosed. Given the wide variety of ways measurement items

could be collected and used together to evaluate performance, the results would not have been predictable.

The specification provides an example in the form of a pilot test that is described on pages 9-13 and in Figures 3-8. However, the example does not show how the measurement items are measured or how they are related to results for performance.

One of ordinary skill would be reduced to trial and error and would require an undue amount of experimentation to duplicate the experimental results disclosed in the pilot test since it is not known how the measurement items are measured or used to get the performance results.

#### **(10) Response to Argument**

Appellant states that claims 1-9 and 11-12 are definite, sufficiently supported by the specification and include the elements that are critical or essential to the practice of the invention. Appellant further states that “broad language in the disclosure, including the abstract, omitting an allegedly critical feature tends to rebut the argument of criticality (see M.P.E.P 2164.08©).” While missing features may not be critical or essential to the invention, it is maintained that claims 1-9, 11 and 12 do not meet the enablement requirement because the claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Appellant states that the 26 measured items are descriptive, and a person of ordinary skill in the related art of supply chain performance can immediately utilize the response to each of the items to evaluate the performance. Appellant states that it is

typical to set a value of "1" to "5" for the level of satisfaction. However, neither the specification, the prior art or any indication of the skill of one of ordinary skill in the prior art teaches how any such values would be used to determine the supply chain performance.

Appellant states that the questionnaire is, in fact, an enabling mechanism that makes it possible for users to evaluate their supply chain performance in the context of transport logistics. However, as stated above, there is no disclosure for how any information gathered from such a questionnaire would be used to evaluate supply chain performance. Further, this missing information is not found in the prior art or the knowledge of one of ordinary skill in the art.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

mlb 

24 January 2007

Conferees:

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Application/Control Number: 10/690,821  
Art Unit: 2857

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